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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM D. EVANS

Appeal 2008-0804
Application 09/766,142
Technology Center 2100

Decided: December 10, 2008

Before LANCE LEONARD BARRY, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 15-29, 35, 37, 38, 41, and 42. We have jurisdiction under 35 U.S.C. § 6(b). Claims 1-14, 30-34, 36, 39, and 40 were cancelled. We reverse.

The Invention

The disclosed invention relates generally to controlling access to electronic documents (Spec. 1). More particularly, a user may make and may limit access to annotations or comments to an electronic document (Spec. 6).

Independent claim 15 is illustrative:

15. A secure content object for distributing and controlling access to a document and annotations associated with the document, comprising:
 - an electronic document, the electronic document having been encrypted with a document encryption key, wherein access to the electronic document is available to a first set of authorized users;
 - an encrypted header comprising information pertaining to the electronic document;
 - a first multi-key encryption table for use in a multi-key encryption method associated with the electronic document, the first table comprising at least one multi-key component associated with each authorized user in the first set and a plurality of dummy encryption components, wherein the multi-key encryption table includes no information that may identify a user or the electronic document;
 - a plurality of annotations associated with the electronic document, generated by an annotation author and having been encrypted with an annotation encryption key, wherein access to the plurality of annotations is available to authorized annotation users comprising the

annotation author and those users in the first set having been designated by the annotation author as having access to the plurality of annotations;

a second multi-key encryption table for use in a multi-key encryption method associated with the plurality of annotations, the second table comprising at least one multi-key component associated with each authorized annotation user; and

a user interface device comprising unencrypted information for identifying the electronic document and an interactive element for enabling a user to input a user authorization for access to at least a portion of the encrypted electronic document, for inputting the user authorization to a decryption engine using the multi-key encryption method for combining the user authorization with each of the multi-key components in the first multi-key encryption key table to decrypt the encrypted header, and for combining the user authorization with each of the stored multi-key components in the second multi-key encryption key table to decrypt an annotation,

wherein upon a valid decryption of the annotation indicates the correct annotation encryption key has been found and the user is an authorized annotation user; and upon a valid decryption of the encrypted header, for enabling decryption of the portion of the encrypted electronic document.

The References

The Examiner relies upon the following references as evidence in support of the obviousness rejection:

| | | |
|------------|--------------|---------------|
| Saito | US 5,740,246 | Apr. 14, 1998 |
| Carter | US 5,787,175 | Jul. 28, 1998 |
| Follendore | US 6,011,847 | Jan. 4, 2000 |

The Rejection

The Examiner rejects claims 15-29, 35, 37, 38, 41, and 42 under 35 U.S.C. § 103(a) as being unpatentable over Carter, Follendore and Saito.

ISSUE

The Examiner finds that “Saito teaches that an original document is edited by an editor (annotation author) and the edited material is encrypted with a key” (Ans. 17).

Appellant asserts that “Saito does not teach that “access to the plurality of annotations is available to authorized annotation users comprising the annotation author and those users in the first set having been designated by the annotation author as having access to the plurality of annotations” (App. Br. 9).

Did Appellant demonstrate that the Examiner erred in concluding that Saito discloses access to a plurality of annotations in a document to users having been designated by the annotation author?

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. Saito discloses that “new data is produced by editing a plurality of encrypted data which are obtained from the database and is encrypted to be supplied to others” (col. 12, ll. 42-44).
2. Saito discloses that “the user decrypts the encrypted second secret-key by the second private-key so that the decrypted second secret-key is used as a crypt key for data storage, copy and transfer after the decryption of the data” (col. 12, ll. 34-38).
3. Saito discloses that “the crypt key . . . with a digital signature are used as a use permit key” (col. 12, ll. 44-47).
4. Saito discloses that a user “requests . . . [to] use [data] by presenting the digital signature” to a management center and the management center “recognizes the editor (of the data) on the basis of the digital signature” (col. 12, ll. 48-52).
5. Saito discloses that “[o]nly in the case where it is recognized that the editor is the authorized user of the edited data, the crypt key for use is provided to those who request for use” (col. 12, ll. 52-54).

PRINCIPLES OF LAW

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’

KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

The Federal Circuit recently recognized that “[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those

skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1740-41).

ANALYSIS

We agree with the Examiner that Saito discloses an editor editing encrypted data (FF 1) and that the edited data may include "annotations" of the data. Also, Saito discloses that a user requests access to the edited data (FF 4) and a crypt key is provided to the requesting users (FF 5). However, the Examiner has not demonstrated that Saito also discloses that the users having access to the annotations or edited data are designated by the annotation author. Rather, Saito discloses that the management center recognizes the editor of the data (i.e., the annotation author) and provides access to the requesting user based on recognition of the editor such that data access is granted to a user based on whether the editor (or annotation author) is a recognized user. We find that this system differs from one in which an editor (or annotation author) designates which users are given access to the edited data as recited in independent claim 15.

Similarly, independent claim 35 recites “each authorized user having been designated by the first user as having access to the annotation” in which the first user generates the “plurality of annotations pertaining to the electronic document” (App. Br. A-4). As set forth above, although Saito discloses a system in which data access is granted to users based on recognition of an editor of the data, Saito does not disclose that data access is granted to users designated by the editor of the data (i.e., “first user”) as recited in independent claim 35.

Accordingly, we conclude that Appellant has met the burden of showing that the Examiner erred in rejecting independent claims 15 and 35. Therefore, we reverse the Examiner’s rejection of independent claims 15 and 35, and of claims 16-29, 37, 38, 41, and 42, which depend therefrom.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants demonstrated that the Examiner erred in concluding that Saito discloses access to a plurality of annotations in a document to users having been designated by the annotation author.

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DECISION

We reverse the Examiner's decision rejecting claims 15-29, 35, 37, 38, 41, and 42 under 35 U.S.C. § 103.

REVERSED

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